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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,680	11/20/2000	Timo E. Sivula		8410

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Fairfield, CT 06430-6232

EXAMINER
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D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2683

12

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/716,680

Applicant(s)

SIVULA, TIMO E.

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5 and 7-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 0200 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection. New art has been cited to reject the amended claims. This Office Action represents continuing examination after the applicant's filing of an RCE and amendment dated 2-26-04.

### *Specification*

The title of the invention is not descriptive (based on the amendment). A new title is required that is clearly indicative of the invention to which the claims are directed.

The examiner suggests that the title be changed to "charging for telecommunication download services" since the amendment focuses the application more on downloading of content than on generic telecommunication service.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 3-5, 8-9 and 12-15** are rejected under 35 U.S.C. 102(e) as being anticipated by Spagna et al. US 6,587,837 (hereafter Spagna).

As per **claim 1**, Spagna teaches a method for prepayment of a content (abstract teaches electronic delivery of content, and figure 1c #182, #183 teach payment verification and billing), comprising:

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Informing the user of the availability of a plurality of different contents for downloading (figure 1d shows end user devices #109 connecting to content hosting site(s) #111 and C1, L50-57)

Receiving from the user over a first communications link an indication of a desired content and a request for the desired content (figure 16 shows how a user can search a library, click on a selected album, select playlist and record/download the song(s) selected, also see C93, L60 to C94, L30 which discloses selecting content)

receiving from the user an authentication key to indicate prepayment for the requested content AND verifying the validity of the authentication key (C15, L51 to C19, L50 teaches use of security keys and authentication while electronic payment is disclosed as well, C14, L15-48 and C25, L43-49)

providing the requested content to the user over a second link (figure 14 shows the user's selection is downloaded after payment)

The examiner interprets first/second communication links as the Transmit and Receive channels on a communications link.

As per **claim 3**, Spagna teaches claim 1 wherein an authentication key is required each time a content is provided (C15, L51 to C19, L50 teaches use of security keys and authentication while electronic payment is disclosed as well, C14, L15-48 and C25, L43-49 – the examiner notes that Spagna discloses security keys and payment via VISA/MASTERCARD [C14, L40-48] which will be verified each time the user accesses the download site and attempts to download music – eg. the user's identity will be verified and the credit card will be debited).

As per **claim 4**, Spagna teaches claim 1 further comprising:

The step of arranging each of the authentication keys to indicate a time period during which they are valid,

The step of verifying validity of authentication keys by comparing present date with time period the key is valid,

The step of rejecting expired keys (C17, L37-46 teaches Digital Certificates and expiration date which reads on keys, valid time period and validating said keys).

The examiner notes that an expiration date inherently requires something/someone to verify that the date is valid and hence reads on the steps of verifying validity of authentication keys/certificates based on date/time and rejecting expired keys.

As per **claim 5**, Spagna teaches claim 1 wherein the method further comprises the following before receiving the request from the user:

Generating the authentication key

Maintaining an authentication key validity database for verifying the validity of any of the generated authentication keys and

Delivering the authentication key to a user (figure 3 and C18, L47 to C19, L50 which teaches transmission of an encrypted symmetric key to the user and they then decrypt the key to use, specifically steps #304 and #417). The examiner notes that Spagna's invention is hosted on computers and would inherently store/manage keys in a commercially available computer database.

As per **claim 8**, Spagna teaches claim 5 wherein the method further comprises the step of modifying the validity database on providing the requested content so that the monetary value corresponding to the authentication key indicating the payment is reduced according to a price of the content requested by the user (electronic payment is disclosed C14, L15-48 and C25, L43-49 – the examiner notes that Spagna discloses payment via VISA/MASTERCARD [C14, L40-48] which will be verified each time the user accesses the download site and attempts to download music – eg. the user's identity will be verified and the credit card will be debited).

As per **claim 9**, Spagna teaches claim 1 wherein the authentication key is a printed user readable code (Spagna teaches use of authentication keys, table in column 16, which can be printed and input by a human into a computer system as well as use of credit cards [C14, L40-48] which have a user readable account number/code. Both read on the claim).

As per **claim 12**, Spagna teaches claim 1 wherein the first communications link is based on at least one of the following: data network, phone network, mobile network, LAN and WAN (C1, L50-57 teaches communications via the Internet/PSTN and one

skilled realizes that LAN/WAN connections are typically required for access to the Internet [from work] and may be wired or wireless connection [eg. wireless LAN]).

As per **claim 13**, Spagna teaches claim 1 wherein the method comprises:

Allowing a user to test a service requested and Receiving final verification from the user before the user is provided the service (C76, L53-57 teaches the user receiving a "preview clip" of music which reads on "testing a service" and provides means for the user to make a final decision to purchase the music or not).

As per **claim 14**, Spagna teaches a system for prepayment of a content (abstract teaches electronic delivery of content, and figure 1c #182, #183 teach payment verification and billing), comprising:

Means for informing the user of the availability of a plurality of different contents for downloading (figure 1d shows end user devices #109 connecting to content hosting site(s) #111 and C1, L50-57)

Means for receiving from the user over a first communications link an indication of a desired content and a request for the desired content (figure 16 shows how a user can search a library, click on a selected album, select playlist and record/download the song(s) selected, also see C93, L60 to C94, L30 which discloses selecting content)

Means for receiving from the user an authentication key to indicate prepayment for the requested content AND verifying the validity of the authentication key (C15, L51 to C19, L50 teaches use of security keys and authentication while electronic payment is disclosed as well, C14, L15-48 and C25, L43-49)

Means for providing the requested content to the user over a second link (figure 14 shows the user's selection is downloaded after payment).

The examiner interprets first/second communication links as the Transmit and Receive channels on a communications link.

As per **claim 15**, Spagna teaches a computer program product for prepayment of a content (abstract teaches electronic delivery of content, and figure 1c #182, #183 teach payment verification and billing hosted on various computer systems which inherently requires computer software programs), comprising:

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Computer readable program means for causing a computer to inform the user of the availability of a plurality of different contents for downloading (figure 1d shows end user devices #109 connecting to content hosting sites/computers #111 and C1, L50-57)

Computer readable program means for receiving from the user over a first communications link an indication of a desired content and a request for the desired content (figure 16 shows how a user can search a computer library, click on a selected album, select playlist and record/download the song(s) selected, also see C93, L60 to C94, L30 which discloses selecting content)

Computer readable program means for receiving from the user an authentication key to indicate prepayment for the requested content AND verifying the validity of the authentication key (C15, L51 to C19, L50 teaches use of security keys and authentication while computer electronic payment is disclosed as well, C14, L15-48 and C25, L43-49)

Computer readable program means for causing a computer to provide the requested content to the user over a second link (figure 14 shows the user's selection via computer is downloaded after payment).

The examiner interprets first/second communication links as the Transmit and Receive channels on a communications link.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna and further in view of Elgamal US 5,671,279 (hereafter Elgamal).

As per **claim 7**, Spagna teaches claim 4 **but is silent on** wherein

Scanning a database of used authentication keys for detecting/removing lapsed authentication keys from said database.

Elgamal teaches detection of a key expiring and a renewal is needed for continuation of service. A new CSR is submitted to the same address used previously for obtaining a certificate to get a new certificate. The two certificate are allowed to overlap in validity periods for one day in order to avoid problems with different time zones. A new key may be required for a new certificate depending on the policy set by the certification authority (C18, L20-27). One skilled realizes that the keys and expiration dates would be stored in a computer database.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Spagna, such that a database is scanned and detects/removes lapsed keys, to provide means for automatically keeping the security keys up-to-date which reduces fraud and increases security.

**Claims 10-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna and further in view of Sultan US 6,270,406 (hereafter Sultan).

As per **claim 10**, Spagna teaches claim 1 **but is silent on** concealing the authentication key with a non-reversibly removable concealing means.

Sultan teaches a Scratch-off, non-reversibly removable concealing means (eg. lottery tickets) to prevent theft or fraud (abstract and figures 1-2).

It would have been obvious to one skilled in the art at the time of the invention to modify Spagna, such that the authentication key is concealed with non-reversibly removable means, to prevent the inadvertent stealing of the key without the user knowing it had been compromised/stolen.

As per **claim 11**, Spagna teaches claim 9 **but is silent on** wherein the method further comprises printing a group of authentication keys on a card.

Sultan teaches a method that conceals a plurality of printed articles/symbols on a card (eg. lottery card) which one skilled would use to print multiple authentication keys on one card (abstract and figures 1-2).



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It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Spagna, such that a group of authentication keys are printed on a card, to reduce the cost of printing/distributing one security key per one card.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMD  
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